

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 020375-041300US	
I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office, Attn: Mail Stop AF, on <u>January 14, 2009</u> . TOWNSEND and TOWNSEND and CREW LLP Signature <u>/Joni E. Peterson/</u> Typed of printed name <u>Joni E. Peterson</u>		Application Number 10/731,038	Filed December 9, 2003
		First Named Inventor Lisa C. Tidwell	
		Art Unit 3696	Examiner Hao Fu
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a Notice of Appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		<u>/William J. Daley/</u> Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		<u>William J. Daley</u> Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,471</u>		<u>(303) 571-4000</u> Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____		<u>January 14, 2009</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

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on January 14, 2009.

**STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

TOWNSEND and TOWNSEND and CREW LLP

By: /Joni E. Peterson/
Joni E. Peterson

PATENT
Attorney Docket No.: 020375-041300US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Lisa C. Tidwell et al.

Application No.: 10/731,038

Filed: December 9, 2003

For: SYSTEMS AND METHODS FOR
ASSESSING THE RISK OF A
FINANCIAL TRANSACTION USING
RECONCILIATION INFORMATION

Customer No.: 20350

Confirmation No.: 6744

Examiner: Hao Fu

Art Unit: 3696

**STATEMENT OF REASONS IN
SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

***Via EFS-Web
Mail Stop AF***
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of the Pre-Appeal Brief Request for Review, that is submitted herewith. The applicants respectfully request review of the final rejection mailed by the U.S. Patent Office for the above-identified application on October 16, 2008 (“the Final Office Action”).

A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

Claims 1-7, 13-16, and 27-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Pub. No. 2005/0080717 of Belyi et al. (hereinafter “Belyi”) in view of U.S. Patent No. 7,257,246 to Brodie et al. (hereinafter “Brodie”), and U.S. Patent Pub. No. 2003/0172030 of Volgunin (hereinafter “Volgunin”). Claims 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Belyi in view of Brodie and Volgunin, and further in view of U.S. Patent Pub. No. 2004/0138975 of Engel et al. (hereinafter “Engel”).

2. Reasons for Requesting Review

35 U.S.C. § 103 Rejection, Belyi in view of Brodie, and Volgunin

Claims 1-7, 13-16, and 27-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Pub. No. 2005/0080717 of Belyi et al. (hereinafter “Belyi”) in view of U.S. Patent No. 7,257,246 to Brodie et al. (hereinafter “Brodie”), and U.S. Patent Pub. No. 2003/0172030 of Volgunin (hereinafter “Volgunin”). The Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims, as amended. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). As will be discussed below, the references cited by the Office Action do not teach or suggest each claimed limitation. For example, none of the references, alone or in combination, teach or suggest assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category.

Belyi is directed to “a system and method of risk assessment, whereby additional information is obtained from the customer and/or the merchant at a point of sale for validation of a financial transaction.” (paragraph 3) Belyi describes obtaining additional transaction

information such as a customer's recent check writing history for use in re-evaluating a transaction. (paragraphs 32-34) However, as noted in the final Office Action, Belyi does not teach or suggest assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category.

Brodie is directed to “authenticating a check-cashing transaction and assessing risks associated with a check-cashing transaction.” (Col. 1, lines 14-16) Brodie describes a situation in which a particular check cashing transaction has exceeded risk management guidelines. In such a case, Brodie describes using a positive pay file to determine whether to override the guidelines. See col. 13, lines 37-60. However, as noted in the final Office Action, Brodie does not teach or suggest, alone or in combination with Belyi, assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category. The final Office Action introduces Volgunin in an effort to demonstrate a teaching of these recitations.

Volgunin “relates to extracting the payee name from check images and verifying the payee name before allocating funds and processing the bank check at the bank.” (paragraph 1) More specifically, Volgunin describes “locating the payee name field of the check, extracting the information in the payee name field, separating the name out of the information in the payee name field and authenticating the payee name against the payee name in the check issued file.” (paragraph 5) However, Volgunin does not teach or suggest assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category. Rather, Volgunin describes verifying a name of a payee from a check and then disbursing funds to the payee based on the verification. (See paragraphs 21 and 22) To any extent that this verification can be considered to teach or suggest assigning a positive pay category, e.g., “yes” or “no” of verified or not verified, as suggested by the final Office Action, Volgunin does not further teach or suggest determining a positive pay risk score based at least in part on a category. Rather, Volgunin describes only a pass/fail verification of the payee name.

Claim 1, upon which claims 2-7 and 27 and 28 depend, recites in part “accessing stored positive pay information about issued checks wherein said positive pay information

indicates whether a check issuer is willing to honor the presented check so as to reimburse an entity who has provided cash in return for accepting the check; assigning a positive pay category based on a comparison of the stored positive pay information and the received information about the check; and determining a positive pay risk score associated with cashing the presented check based at least in part on the assigned positive pay category.” None of the references, alone or in combination, teach or suggest assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of claims 1-7, 27, and 28.

Claim 13, upon which claims 14-16 depend, recites in part “a database that stores positive pay information about checks issued by check writers to payees wherein said positive pay information indicates issued checks that check writers are willing to honor; a computer processor configured to receive input about a check presented to an entity by a check presenter claiming to be a payee, the computer processor further configured to use the input to access positive pay information from the database that is associated with the payor of the check and assign a positive pay category based on a comparison of the positive pay information from the database and the received input about the check, the computer processor further configured to determine a positive pay risk score associated with accepting the check and providing cash to the payee in return for accepting the check based at least in part on the positive pay category.” None of the references, alone or in combination, teach or suggest assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of claims 13-16.

35 U.S.C. § 103 Rejection, Belyi in view of Brodie and Volgunin, and further in view of Engel

Claims 8-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belyi in view of Brodie and Volgunin, and further in view of U.S. Patent Pub. No. 2004/0138975 of Engel et al. (hereinafter “Engel”).

As noted above, Belyi, Brodie, and Volgunin do not teach or suggest, alone or in combination, assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category. Engle is directed to processing orders for paper checks. See paragraph 7. However, Engle is not directed to and does not disclose scoring risk associated with cashing a check or using a positive pay file in doing so. Thus, Engle also fails to teach or suggest, alone or in combination with the other references, assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category.

Claim 8, upon which claims 9-11 depend, recites in part “accessing the identified positive pay database associated with the second-party check and comparing the transmitted data and information stored in the positive pay database; assigning a positive pay category based on comparing the transmitted data and the information stored in the positive pay database; determining a risk score associated with accepting the second-party check from a processor of the check and providing valuable consideration to the possessor in return for the second-party check based at least in part on the comparison and further based upon the positive pay category.” None of the references, alone or in combination, teach or suggest assigning a positive pay category and determining a positive pay risk score based at least in part on the positive pay category. For at least these reasons, the Applicants respectfully request withdrawal of the rejection and allowance of claims 8-11.

For at least these reasons, the Applicants maintain that the rejection is improper and should be withdrawn.

Respectfully submitted,

Date: January 14, 2009

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